

REMARKS

Applicants gratefully acknowledge the Examiner's withdrawal of the previous office action's rejection under 35 U.S.C. § 101 as a result of amendments presented in response to the previous office action.

Claims 4-10, 12-17, 20-22, 25-34, and 37-45 are currently pending in the application. Claim 3 has been canceled, with the substance of Claim 3 added to Claims 43, 44, and 45 by amendment. In addition, Claims 43, 44, and 45 have been amended by changing "a selected business measure" to "each one of said selected one or a plurality of business measures" (Claim 43, lines 8-9; Claim 44, line 11; and Claim 45, line 11). Support for these amendments may be found in the Specification at page 4, lines 11-12, 16-17, and 17-19. Finally, Claim 45, line 10, has been amended by deleting the words "to permit" to correct an informality. No new matter has been added.

In response to the Examiner's request, confirmation is hereby provided that the subject matter of each claim was commonly owned by the inventors at the time of invention.

The Claimed Invention

The claimed invention describes an apparatus and method of providing business solutions and services via an interactive communications medium, where such solutions and services are currently devised using consultants, accountants, and sales people. The claimed invention provides a method of providing business solutions over an interactive communications medium, which may be the world wide web portion of the Internet. (Figure 4) The method includes selectively providing metrics which are associated with a business problem and a specific industry and providing a business solution based on the selective metrics and responses to the selective metrics, which take the form of a dynamic set of questions. (Figure 1; Specification at 7, line 11) The metrics module 104 may include questions requiring a "yes or no" response or a response within a certain range, enabling the use of industry benchmarks to determine whether a given range is acceptable

or problematic. Alternatively, the metrics module 104 may solicit a more quantitative response. The dynamic set of questions is preferably provided in a hierarchical tree format. (Figure 3) In addition, the claimed invention provides a method for providing business solutions over an interactive communications medium. The method includes identifying a specific industry and providing at least one business measure associated with a particular financial aspect of the specific industry. (Figure 2) The method further includes providing a set of questions associated with problems of the specific industry, where the set of questions are related to each of the provided at least one business measure. Thus, the user response to the question presented by the metrics module 104 is used either to generate new pertinent questions or to map generic solutions provided by a functionality module 106. A functionality is a generalization as to what a solution may accomplish. A business solution is thus provided based on responses to the set of questions and the specific industry. Furthermore, the claimed invention provides a system for providing business solutions over an interactive communications medium. The system further includes a business solution module which provides business solutions based on responses to the selected questions stored in the business metrics module and the specific industry. Finally, the claimed invention provides a machine readable medium containing code for instructing a computer to provide business solutions over an interactive communications medium. The code implements the steps of selectively providing metrics which are associated with a business problem and a specific industry and providing a business solution based on the selective metrics and responses to the selective metrics.

Rejection 35 U.S.C. § 112, Second Paragraph

The Examiner rejected newly-added independent Claims 43, 44, and 45, and dependent Claims 3-10, 12-17, 20-22, 25-34, and 37-42, under 35 U.S.C. § 112, second paragraph, on the basis that, with reference to Claims 43-45:

it's not clear the relationship of element (c) "in performing a qualitative assessment on a selected business measure based on benchmarks" to the remaining elements of the claim. There is no discussion of "assessment"

to the body of the claim.

(Office Action at 2) (emphasis in the original) Applicants note that the claims have been amended to change “qualitative assessment on a selected business measure” to “qualitative assessment on each one of said selected one or a plurality of business measures.” Furthermore, the dynamic set of questions described in element (d) are amended to be based on an assessment from element (c). As amended to address the Examiner’s comments, Claims 43, 44, and 45 particularly point out and distinctly claim the subject matter of the claimed invention, as required by 35 U.S.C. § 112, second paragraph.

Rejection Under 35 U.S.C. § 103(a)

The Examiner rejected independent Claims 43, 44, and 45, and dependent Claims 4-10, 12-17, 25-34, and 37-42, under 35 U.S.C. § 103(a) on the basis that the claims are suggested by U.S. Patent Application No. 2001/0032092 to Calver in view of U.S. Patent Application No. 2002/0042751 to Sarno. The Examiner also rejected independent Claims 43, 44, and 45 and dependent Claims 5-10, 25-27, 32-33, 37-38, and 40 under 35 U.S.C. § 103(a) on the basis that the claims are suggested by Calver in view of Sarno and further in view of U.S. Patent No. 6,591,256 to Friedman.

The Examiner did not reject Claim 3 under 35 U.S.C. § 103(a), and the substance of Claim 3 has been added to Claims 43, 44, and 45 by amendment. As a result, the basis of the Examiner’s rejections under 35 U.S.C. § 103(a) is no longer extant, and all claims should be in condition for allowance.

Claims 4-10, 12-17, 25-34, and 37-45. Applicants respectfully traverse the rejection of Claims 4-10, 12-17, 25-34, and 37-45 under 35 U.S.C. § 103(a) as suggested by Calver in view of Sarno on the basis that the combination is not obvious and, in any event, does not suggest the claimed invention.

Claims 43, 44, and 45 provide a method, system, and machine readable instruction code for providing business solutions over an interactive communications medium, which comprises, among other things, the presentation of:

a dynamic set of questions from among questions electronically stored in a

database which relate to selected business measures of a selected industry, such that questions for a user can be applied to database contents for a plurality of purposes, one of said purposes being to permit a next question to be based on a previous question and a previous answer, and permitting a user to answer said dynamic set of questions.

(Claim 43, lines 11-15; *see also* Claim 44, lines 13-18, and Claim 45, lines 13-18)
(emphasis added)

In responding to the previous office action, Applicants stated, among other things, that Calver does not provide (1) for questions to be generated based on answers to previous questions or (2) for calculation of return on investment. In the most recent Office Action, the Examiner has responded by stating that the basing of questions on previous questions is indeed suggested by Calver and that calculation of return on investment is suggested by Sarno.

The Examiner states that Calver, at paragraphs 0061-63 and 0070, teaches that questions may be generated based on answers to previous questions. (Office Action at 4) The “Drill-Down” process taught by Calver (Calver at 0062 and 0077, cited in the Office Action at 4 and 5), however, is limited to use in web-based portals for small business, which present questionnaires to customers to assist in configuring products (Calver at 0061-63, cited in the Office Action at 4 and 5) or to screen customers according to considerations such as whether their businesses are small, medium, or large (Calver at 0070, cited in the Office Action at 4 and 5). Claims 43, 44, and 45, however, provide that a question may be “based on a previous question and a previous answer” (Claim 43, lines 14-15; Claim 44, line 17; Claim 45, lines 16-17) “for a plurality of purposes” (Claim 43, line 13; Claim 44, line 16; Claim 45, lines 15-16) and do not restrict the purposes for which this may be done, as in Calver.

These distinctions are consistent with the different overall purposes of Calver and the claimed invention. Where Calver describes a web-based portal method and system for small business applications, the claimed invention provides an apparatus and method of providing business solutions and a method and system of selling and justifying

business solutions and services via a dynamic system. A web-based portal does not suggest the claimed invention.

The Examiner also states that Sarno provides a feature for calculating return on investment which is supposedly missing from Claims 43, 44, 45, and certain of their dependencies. Sarno, however, provides systems and methods for business-to-business analysis and presentation of user information for cost justification, which does not suggest the claimed invention's method and system of selling and justifying business solutions and services via a dynamic system

The Examiner has failed to present a reason why it would have been obvious to combine the web-based portal of Calver with Sarno's systems and methods for business-to-business financial transactions. The Examiner's inherency argument (Office Action at 9) is impermissible hindsight and an improper assertion of technical fact in an area of esoteric technology without support by citation of any reference work. *See* M.P.E.P. § 2144.03, citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 422-21 (CCPA 1970).

Claims 5-7, 12-14, 25-27, 32-33, 37-38, 40, and 43-45. Applicants respectfully traverse the rejection of Claims 5-7, 12-14, 25-27, 32-33, 37-38, 40, and 43-45 under 35 U.S.C. § 103(a) as suggested by Calver in view of Sarno and further in view of Friedman on the basis that the combination is not obvious and, in any event, does not suggest the claimed invention.

According to the Examiner, Friedman "discloses the benefits of optimization of specific problem parameters or variables and different rules based model [sic]," which are not to be found in Calver or Sarno. (Office Action at 8) (emphasis in the original) The Examiner also states that Friedman "fairly teaches the concept of optimization of the desired business parameters, i.e. resource allocation, direct transportation cost, network problems, inventory, sequential policy, generic model, queuing theory, etc." (*Id.*)

By introducing Friedman as a factor in the analysis, the Examiner implicitly admits that the features the Examiner (erroneously) finds to be suggested by Friedman are absent from Calver and Sarno, thus undercutting the Examiner's rejection of Claims 5-7,

12-14, 25-27, 32-33, 37-38, 40, and 43-44 as suggested by a combination of Calver and Salvo without consideration of Friedman. In addition, the Examiner cites Friedman only as showing the use of abstract concepts of optimization and not as implementing these concepts in any way that suggests the claimed invention.

Furthermore, the Examiner fails to indicate why it would be obvious to combine Friedman with Calver or Sarno. Since the Examiner has also failed to indicate why it would be obvious to combine Calver and Sarno with each other, as discussed above, the Examiner's conclusion that features of the claimed invention are suggested by a combination of Calver, Sarno, and Friedman is without basis.

Conclusion

In view of the foregoing, Applicant submits that Claims 3-17, 20-22, 25-34, and 37-45 are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Applicants' Deposit Account No. 50-0510 (IBM Corporation).

Respectfully submitted,



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